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OFFICE OF PETITIONS

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| In re Application of | : | |
| Warwick et al. | : | |
| Application No. 10/038,208 | : | DECISION ON PETITION |
| Filed: January 2, 2002 | : | |
| Attorney Docket Number: | : | |
| 39340.1.1.3 | : | |
| | : | |

This is a decision on the "PETITION TO CLAIM BENEFIT UNDER 35 U.S.C. 119(e) OF PRIOR FILED PROVISIONAL APPLICATION (37 C.F.R. § 1.78(a)(6))," filed November 22, 2004. Petitioner requests correction from a claim of priority to provisional application No. 60/084,605 to a claim of priority to provisional application No. 60/142,112. Accompanying this petition are a request for continued examination (RCE) and RCE fee.

The petition is **GRANTED**.

A petition under 37 CFR 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of a prior filed provisional application, is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5), and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) the surcharge set forth in 37 CFR 1.17(t);
- (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5) and the date the claim was filed was unintentional; and
- (3) the reference to the prior filed provisional application, supplied in an application data sheet (ADS) (37 CFR 1.76) or as an amendment in the first sentence of the specification following the title. See 35 USC 119(e) and 37 CFR 1.78(a)(5). The Director may require additional information where there is a question whether the delay was unintentional.

The instant pending nonprovisional application was filed on January 2, 2002, as a continuation of PCT/US00/18037 filed June 29, 2000, with a claim for priority to provisional application No. 60/084,605. Petitioner states that provisional application No. 60/084,605 was identified in error. Rather, applicants intended to make a claim of priority to provisional application No. 60/142,112. The PCT application was filed on June 29, 2000, within twelve months of prior provisional application No. 60/142,112 which was filed on July 2, 1999, and for which priority is claimed. A reference to the prior provisional application has been included as an amendment to the first sentence of the specification following the title and has been supplied in an application data sheet.

The instant nonprovisional application was filed after November 29, 2000, and the claim for priority herein is submitted after expiration of the period specified in 37 CFR 1.78(a)(5). Also, the reference to the prior filed provisional application was submitted during the pendency of the nonprovisional application for which the benefit is sought. See 35 USC 119(e). Accordingly, having found that the instant petition satisfies the conditions of 37 CFR 1.78(a)(6) for acceptance of an unintentionally delayed claim for priority under 35 USC 119(e), the petition to accept an unintentionally delayed claim of benefit to prior filed provisional Application No. 60/142,112 is granted as of the date of filing the petition.

Receipt of the \$1,370 fee required by 37 CFR 1.78(a)(6) is acknowledged.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(6) should not be construed as meaning that the instant application is entitled

to the benefit of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 USC 119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed application, accompanies this decision.

This application is being forwarded to Technology Center Art Unit 3764 for consideration by the Examiner of applicant's claim under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5) for the benefit of priority to the prior-filed provisional application.

Any inquiries concerning this decision may be directed to Senior Petitions Attorney Nancy Johnson at (571) 272-3219.

A handwritten signature in cursive script, reading "Charles A. Pearson". The signature is written in black ink and is positioned above the printed name and title.

Charles A. Pearson
Director
Office of Petitions